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Daniel Patrick Connors

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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

8321 OLD COURTHOUSE ROAD

SUITE 200

VIENNA, VA 22182-3817

EXAMINER

O CONNOR, GERALD J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL PATRICK CONNORS,
JOHN D. MACKAY, and HOWARD E. SACHAR

Appeal 2007-3211
Application 09/825,879
Technology Center 3600

Decided: January 28, 2008

Before WILLIAM F. PATE, MURRIEL E. CRAWFORD, and
HUBERT C. LORIN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Connors, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-13 and 21-26. Claim 27 has been withdrawn and claims 14-20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

The Appellants' claimed invention is to a system for restocking and repricing merchandise. (Specification 1:5-8). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A system for restocking and repricing merchandise, comprising:

a shelf label holder comprising an illuminating device for performing an illuminating function; and

a hand-held unit which remotely causes said illuminating device to illuminate under a predetermined condition,

wherein said illuminating device comprises a plurality of illuminating sections which correspond respectively to locations on a shelf.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Brick	US 6,269,342 B1	Jul. 31, 2001
Adamec	US 6,211,773 B1	Apr. 3, 2001

The following rejection is before us for review:

¹ Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Nov. 13, 2006), Reply Brief ("Reply Br.," filed Apr. 23, 2007), and the Examiner's Answer ("Answer," mailed Feb. 21, 2007).

Claims 1-13 and 21-26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brick and Adamec.

ISSUES

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-13 and 21-26 as unpatentable over Brick and Adamec. This issue turns on whether the prior art would have led one having ordinary skill in the art to a shelf label holder comprising an illuminating device comprising a plurality of illuminating sections which correspond respectively to locations on a shelf.

OPINION

We will not sustain the rejection.

The Examiner stated that “Brick et al. disclose a system for restocking and pricing merchandise, comprising: a shelf label holder; and a hand-held unit which remotely programs said shelf label holder, but the shelf label holder of Brick et al. fails to include an illuminating section which is illuminated by remote control of the hand-held unit under a predetermined condition.” (Answer 3-4). One of the disputes is whether the Examiner is correct in stating that Brick discloses a “shelf label holder.” (See App. Br. 9-10). We have reviewed Brick. We are uncertain as to what disclosure in Brick the Examiner is relying upon to show the claimed “shelf label holder.” In setting out the prima facie case of obviousness, the Examiner did not indicate where in Brick the holder was disclosed. (Answer 3-4). The Appellants’ pointed this out, arguing that Brick disclosed a shelf tag rather

than a shelf label holder (see App. Br. 9-10). The Examiner responded by arguing that Brick's apparatus contains all the structure limitations claimed for the holder and is nevertheless "capable of performing the intended use" of holding a label. (Answer 8). But the Examiner still did not explain where in Brick a shelf label holder is disclosed. In making out a prima facie case of obviousness, it is incumbent on the Examiner to clearly present facts leading to a determination of the scope and content of the prior art. The question of obviousness is resolved on the basis of underlying factual determinations including (1) *the scope and content of the prior art*, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007) ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

Both independent claims 1 and 27 require the claimed apparatus to comprise "a shelf label holder." Given Fig. 10 of Brick, which shows a device 330 comprising a "housing" (col. 12, l. 64) with a "display means 342 [which] preferably takes the form of a code (e.g., a bar code) printed on a *label* or sticker which is applied to the housing of shelf tag 330," Brick arguably discloses a shelf label holder, notwithstanding that Brick calls device 330 a shelf tag (col. 12, l. 6).

However, the claims further require the shelf label holder to comprise an illuminating device for performing an illuminating function and which comprises "a plurality of illuminating sections which correspond respectively to locations on a

shelf.” The Examiner appears to have conceded that this is not disclosed in Brick (“the shelf label holder of Brick et al. fails to include an illuminating section which is illuminated ...,” Answer 4). We are equally unable to find in Brick any suggestion of an illuminating device. To meet this claimed feature, the Examiner relied on Adamec which, according to the Examiner, “disclose[s] a similar system [to Brick] for restocking and repricing merchandise, and the shelf label holder of [Adamec] indeed includes a plurality of illuminating sections which are illuminated by remote control of the hand-held unit under a predetermined condition (see, in particular, column 4, line 32 et seq.).” (Answer 4).

As with Brick, the Examiner did not clearly explain where in Adamec a shelf label holder comprising an illuminating device for performing an illuminating function comprising a plurality of illuminating sections which correspond respectively to locations on a shelf is disclosed. The Examiner referred to column 4, beginning at line 32. However, that section of Adamec does not appear to describe a shelf label holder. It appears to describe parts of a remote control. The disclosure most relevant to an illuminating device appears to be at col. 4, ll. 34-36 (“[i]ndicators 45a and 45b [which] may include self-contained electronic beepers, lights, or tactile indicators”) but the elements described there refer to the remote control 24 (col. 2, ll. 65-66). See Adamec, Fig. 2A. We also do not see any disclosure suggesting the illuminating elements of Adamec may be remotely caused to illuminate under a predetermined condition as required by the claims.

Finally, we are unable to discern from the Examiner’s position a logical rationale for combining the disclosures of Brick and Adamec, given their scope

and content, that would lead one of ordinary skill in the art to the claimed system. The Examiner stated that “it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Brick et al. so as to include an illuminating section in the shelf label holder which would be illuminated by remote control of the hand-held unit under a predetermined condition, in accordance with the teachings of Adamec et al., in order to facilitate locating the shelf label holder to be programmed.” (Answer 4). However, even if we assumed *arguendo* that Brick discloses a device with structure allowing it to function as a shelf label holder, the Examiner fails to explain how modifying such a device to incorporate the illuminating indicators of Adamec’s remote control would yield the system claimed, one which requires not only that the illuminating device comprise a plurality of illuminating sections which correspond respectively to locations on a shelf but that the illuminating device be remotely caused to illuminate by a hand-held unit under a predetermined condition. We are not persuaded that the Examiner’s reasoning supports a legal conclusion of obviousness. In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting claims 1-13 and 21-26 as unpatentable over Brick and Adamec.

Appeal 2007-3211
Application 09/825,879

DECISION

The decision of the Examiner to reject claims 1-13 and 21-26 is reversed.

REVERSED

JRG

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